

### **REMARKS**

Claims 1-43 were filed with the present Application. By this Amendment, claims 1, 15, 18, 21, and 24 have been amended, claims 44-46 have been added, and claims 2, 3, and 32-42 have been cancelled. Accordingly, claims 1, 4-31, and 43-46 are currently at issue and subject to examination.

### **Examiner Interview**

Examiner Castellano conducted a telephone interview with Applicants' attorneys Peter M. Siavelis and Gregory G. Schlenz on June 30, 2006. Applicants and their attorneys thank Examiner Castellano for his time in conducting the interview.

In the interview, the references cited by the Examiner were discussed, including U.S. Design Patent No. Des. 196,271, and U.S. Patent Nos. 6,575,320 and 3,223,305. The Examiner also referenced several new references, including U.S. Patent Nos. 3,831,745, 5,988,417, and 3,091,360. Several of the pending claims were discussed, including claims 1, 7, 13, and 14, as well as potential amendments to claim 1 and other independent claims. No agreement was reached regarding patentability of the rejected claims.

### **Rejections Under 35 U.S.C. § 102(b)**

The Examiner rejected claims 1-6, 8-10, 13-20, 22, 24-28, and 31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Design Patent No. Des. 196,271 to Edwards ("Edwards"). In view of the amendments herein, Applicants submit that claims 1-6, 8-10, 13-20, 22, 24-28, and 31 are patentable over Edwards.

In order for a reference to constitute a §102(b) bar to patentability, the reference must disclose each and every element of the claimed invention. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983). The burden of establishing a prima facie case of anticipation resides with the Patent & Trademark Office. *Ex Parte Skinner*, 2 U.S.P.Q. 2d 1788 (BPAI 1986). Applicants submit that Edwards does not disclose, teach, or suggest all the elements of claims 1, 2, 4-12, 14, and 15.

**A. Claims 1-6, 8-10, 13, and 14**

Claim 1, as amended, includes, among other elements, “the annular shoulder forming an inner stacking surface on the inner surface of the sidewall and the arched portion forming a raised ledge on the inner stacking surface, wherein the base of a second identical container rests upon the inner stacking surface and the raised ledge sits within the arched portion of the second identical container when the second identical container is nested upon the container.” Applicants submit that Edwards does not disclose, teach, or suggest at least this element of claim 1.

As noted by the Examiner, Edwards discloses a packaging cup having a sidewall that includes a “zigzag” formation of substantially straight lines and a formation of substantially curved lines at the approximate mid-height of the cup. The Examiner asserts, on page 2 of the Office Action, that the zigzag formation defines longitudinal recesses and the curved line formation defines an annular shoulder having arched portions. Even if the Examiner is correct in these assertions, Edwards does not disclose the above element of claim 1. The curved line formation, asserted by the Examiner to be the recited annular shoulder, is located at the approximate mid-height of the cup of Edwards. From examination of the drawings of Edwards, one of skill in the art of plastic cup design recognizes that when the cup of Edwards is stacked upon a second identical cup, no portion of the bottom surface of the cup rests upon an inner surface formed by the annular shoulder. Rather, stacking is likely accomplished by the broken-line “skirt” located above the base of the cup of Edwards.<sup>1</sup> Further, any “inner surface” of the cup of Edwards which accomplishes stacking does not contain any raised ledges formed by the arched portions, because the alleged arched portions are located higher up on the sidewall of the cup of Edwards. Thus, Edwards does not disclose, teach, or suggest the above element of claim 1, and Edwards cannot anticipate claim 1.

Claims 4-6, 8-10, 13, and 14 depend from claim 1 and contain all the elements of claim 1. Thus, for the reasons stated above with respect to claim 1, Edwards does not anticipate claims 4-6, 8-10, 13, and 14, and these claims are allowable.

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<sup>1</sup> See also U.S. Patent No. 3,091,360, to Edwards, identified by the Examiner in the interview, for further support. The ‘360 Patent apparently contains a similar skirt structure to that of Edwards. FIGS. 10 and 12-14 illustrate the stacking arrangement of the ‘360 Patent, accomplished by the skirt structure just above the base.

**B. Claims 15-17**

Claim 15, as amended, includes, among other elements, “the sidewall comprising an arcuately formed longitudinal recess and a stacking shoulder, the arcuately formed longitudinal recess having an upper end portion having a width that is greater than a width at an intermediate portion of the recess.” Applicants submit that Edwards does not disclose, teach, or suggest at least this element of claim 15.

As noted above, Edwards discloses a packaging cup having a sidewall that includes a “zigzag” formation of substantially straight lines and a formation of substantially curved lines at the approximate mid-height of the cup. The Examiner asserts, on page 2 of the Office Action, that the zigzag formation of substantially straight lines forms longitudinal recesses. However, even if the Examiner is correct, the recesses are not arcuately formed recesses. As defined in the specification, arcuately formed recesses are, “circumferentially wider towards the top 12 and bottom and narrower in the middle.” (See Application, P. 8, Lines 21-23). Applicant has amended claim 15 to incorporate this definition of arcuately formed. In contrast, the recesses of Edwards’ cup are triangular, forming a point at the top and continuously widening as they progress toward the bottom of the cup. Thus, Edwards does not disclose, teach, or suggest this element of claim 15, and cannot anticipate claim 15. Because the present amendment only incorporates the definition of “arcuately formed” already set forth in the specification, the present amendment does not narrow the scope of claim 15 and is made only for clarification purposes.

Claims 16 and 17 depend from claim 15 and contain all the elements of claim 15. Thus, for the reasons stated above with respect to claim 15, Edwards does not anticipate claims 16 and 17, and these claims are allowable.

**C. Claims 18-20, 22, 24-28, and 31**

Claim 18, as amended, includes, among other elements, “the lower portion comprising a number of beveled portions equal to the number of recesses, wherein each beveled portion defines a beveled edge on the base.” Applicants submit that Edwards does not disclose, teach, or suggest at least this element of claim 18.

As clarified by the Examiner in the interview, the Examiner asserts that Edwards discloses one or more beveled portions in a segmented arrangement around the “skirt” region above the base of the cup of Edwards. Applicants submit that these structures are not beveled portions as recited in claim 18 and defined in the present specification. However, even if these structures in Edwards were considered to be beveled portions, they do not define beveled edges on the base of the cup. Applicants have amended claim 18 to clarify that the base is on the bottom horizontal surface of the container, to address the Examiner’s concerns raised in the interview. As described during the interview and shown in FIGS. 1 and 2 below, the notched structures relied on by the Examiner terminate above the base of the cup, thereby forming a gap above the base.

Fig.1

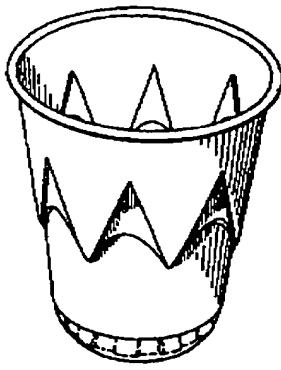
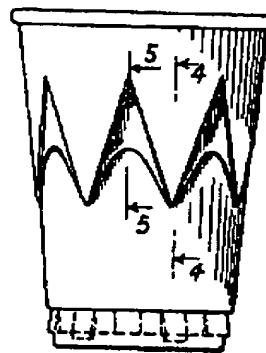


Fig.2



Further, FIG. 3 of Edwards clearly illustrates that the base of the cup is completely circular. (See also FIG. 7 of U.S. Patent No. 3,091,360, to Edwards, identified by the Examiner in the interview, for further support). Accordingly, the base of Edwards’ cup lacks beveled edges. Thus, Edwards does not disclose, teach, or suggest this element of claim 18, and cannot anticipate claim 18.

Claims 19-20, 22, 24-28, and 31 depend from claim 18 and contain all the elements of claim 18. Thus, for the reasons stated above with respect to claim 18, Edwards does not anticipate claims 19-20, 22, 24-28, and 31, and these claims are allowable.

**Rejections Under 35 U.S.C. § 103(a)**

**A. Claim 7**

The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Edwards in view of U.S. Patent No. 3,223,305 to Edwards (“Edwards ‘305”). In view of the amendments herein, Applicants submit that the Examiner has not presented a *prima facie* case of obviousness with respect to claim 7, and claim 7 is patentable over the cited prior art.

It is the burden of the Patent and Trademark Office to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103. *In re Reuter*, 210 U.S.P.Q.2d 249 (CCPA 1981). To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion, incentive or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art references must teach or suggest all the claim limitations. See *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1988). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). It is well-recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed device obvious. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (“one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”).

Claim 7, via dependency from claim 1, includes, among other elements, “the annular shoulder forming an inner stacking surface on the inner surface of the sidewall and the arched portion forming a raised ledge on the inner stacking surface, wherein the base of a second identical container rests upon the inner stacking surface and the raised ledge sits within the arched portion of the second identical container when the second identical container is nested upon the container.” As stated above with respect to claim 1, Edwards does not disclose this element of claim 7. Applicants submit that Edwards ‘305 also does not disclose, teach, or suggest at least this element of claim 7.

Edwards '305 discloses several different embodiments of a cup, each embodiment having several fins (40) on the outer surface. The Examiner has not asserted that Edwards '305 contains an annular shoulder having an arched portion as recited in claim 1. Additionally, it is clear from the FIGS. of Edwards '305 that the disclosed cup has no inner stacking surface, with a raised ledge, upon which the base of a second identical cup sits when stacked. Thus, Edwards '305 also does not disclose this element of claim 7, and the proposed combination of Edwards and Edwards '305 cannot render claim 7 obvious.

Additionally, Edwards and Edwards '305 are not properly combinable to form an obviousness rejection of claim 7. The ribs of Edwards '305 cannot be added to the cup of Edwards without rearranging its structure. The zig-zag and curved line formations at the mid-height of the cup of Edwards would directly interfere with the fins (40) that extend across the sidewall of the cup of Edwards '305. If the proposed modification or combination of the prior art would change the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959). Other than hindsight reconstruction, there is no motivation to make the proposed combination. Thus, combination of the two references, incorporating these structures, is not proper, and the Examiner has not presented a *prima facie* case of obviousness with respect to claim 7.

## B. Claims 9-12

The Examiner rejected claims 9-12 under 35 U.S.C. § 103(a) as being unpatentable over Edwards. In view of the amendments herein, Applicants submit that the Examiner has not presented a *prima facie* case of obviousness with respect to claims 9-12, and claims 9-12 are patentable over the cited prior art.

Claims 9-12, via dependency from claim 1, include, among other elements, "the annular shoulder forming an inner stacking surface on the inner surface of the sidewall and the arched portion forming a raised ledge on the inner stacking surface, wherein the base of a second identical container rests upon the inner stacking surface and the raised ledge sits within the arched portion of the second identical container when the second identical container is nested

upon the container.” As stated above with respect to claim 1, Edwards does not disclose this element of claims 9-12. Additionally, there is no motivation provided in the teachings of the prior art to modify Edwards to include this element. Further, Applicant respectfully disagrees with the Examiner that improvement in strength to weight ratio of up to and exceeding 40% by using recesses would be obvious as a simple matter of engineering design. Thus, the Examiner has not presented a *prima facie* case of obviousness with respect to claims 9-12.

### C. Claims 21 and 27-30

The Examiner rejected claims 21 and 27-30 under 35 U.S.C. § 103(a) as being unpatentable over Edwards. In view of the amendments herein, Applicants submit that the Examiner has not presented a *prima facie* case of obviousness with respect to claims 21 and 27-30, and claims 21 and 27-30 are patentable over the cited prior art.

Claims 21 and 27-30, via dependency from claim 18, include, among other elements, “the lower portion comprising a number of beveled portions equal to the number of recesses, wherein each beveled portion defines a beveled edge on the base.” As stated above with respect to claim 18, Edwards does not disclose this element of claims 21 and 27-30. Additionally, there is no motivation provided in the teachings of the prior art to modify Edwards to include this element. Further, Applicants respectfully disagree with the Examiner that improvement in strength to weight ratio of up to and exceeding 40% by using recesses would be obvious as a simple matter of engineering design. Still further, there is no motivation to modify Edwards to change the alignment of the structures therein. First, the motivation cited by the Examiner, “providing an aesthetically pleasing appearance,” is completely subjective and improper. Using the Examiner’s rationale, any structure could be modified in any way to render any invention obvious if the Examiner subjectively considers it “aesthetically pleasing” to do so. Second, Edwards does not disclose any benefit to the alignment of the structures therein. Edwards merely shows a cup having a zig-zag structure and a curved line formation in alignment with each other. Because Edwards contains no verbal disclosure, the reasons and motivations for Edwards’ design are speculative. Thus, the Examiner has not presented a *prima facie* case of obviousness with respect to claims 21 and 27-30.

#### D. Claim 43

The Examiner rejected claim 43 under 35 U.S.C. § 103(a) as being unpatentable over Edwards. In view of the amendments herein, Applicants submit that the Examiner has not presented a *prima facie* case of obviousness with respect to claim 43, and claim 43 is patentable over the cited prior art.

Claim 43 includes, among other elements, “the lower portion comprising two beveled portions aligned with the longitudinal recesses.” Applicants submit that Edwards does not disclose, teach, or suggest at least this element of claim 43, and further, that there is no motivation to modify Edwards to include this element. This element is identical to the element discussed above with respect to Claim 32. As described above, Edwards does not disclose this element, and there is no motivation to modify Edwards to contain this element.

Claim 43 also includes, among other elements, “two concave, arcuately formed, longitudinal recesses.” Edwards also does not disclose, teach, or suggest this element of claim 43. The specification defines “arcuately formed” recesses as, “circumferentially wider towards the top 12 and bottom and narrower in the middle.” (See P. 8, Lines 21-23). As described above with respect to claim 15, the recesses of Edwards are not arcuately formed. Rather, the recesses of Edwards’ cup are triangular, forming a point at the top and continuously widening as they progress toward the bottom of the cup. Additionally, it appears from FIGS. 4-5 that at least a portion of the recess, if not the entire recess, is convexly curved, rather than concavely curved. In the worst case, it is not clear from the FIGS. of Edwards whether the recesses are concave. Applicants respectfully submit that such speculative disclosure is not sufficient to deny patentability to Applicants’ claim. Further, there is no motivation to modify Edwards to contain concave, arcuately formed recesses, and the Examiner has pointed to no such motivation. As stated above, “providing an aesthetically pleasing appearance” is too subjective to constitute a proper motivation. Thus, the Examiner has not presented a *prima facie* case of obviousness with respect to claim 43.

#### E. Claim 23

The Examiner rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Edwards in view of U.S. Patent No. 6,575,320 to Ota *et al.* (“Ota”). In view of the amendments herein, Applicants submit that the Examiner has not presented a *prima facie* case of obviousness with respect to claim 23, and claims 23-42 are patentable over the cited prior art.

Claim 23, via dependency from claim 18, includes, among other elements, “the lower portion comprising a number of beveled portions equal to the number of recesses, wherein each beveled portion defines a beveled edge on the base.” As stated above with respect to claim 18, Edwards does not disclose this element of claim 23. Additionally, Ota does not disclose, teach, or suggest this element of claim 23, as the disclosed container contains no beveled portions and an apparently completely circular base. Indeed, the Examiner does not assert that Ota discloses this element of claim 23. Further, there is no motivation provided in the teachings of the prior art, or cited by the Examiner, to modify or combine the references to include this element. Thus, the Examiner has not presented a *prima facie* case of obviousness with respect to claim 23.

Additionally, Applicants respectfully disagree with the Examiner’s position that Ota discloses an annular rib having a curved portion aligned with a longitudinal recess. The structure pointed to by the Examiner, “aligned with the upper extent of the circumferentially arranged flat walls 3 of the upper body portion,” is merely an upper part of the structures (3) that the Examiner asserts to be the recited recesses. Applicants submit that it is not proper to consider a single structure of Ota to be both a “rib” and a “recess” when both elements are positively recited as separate elements in the claims. Further, there is no motivation to combine the teachings of Ota with the teachings of Edwards. Ota is directed to a container that is adapted to absorb pressure caused by filling with extremely hot contents (80-95°C). (See Ota, Col. 3, Lines 30-45). The container disclosed in the present application is not typically used with such high-temperature liquids, because the thin walls would not provide sufficient protection from heat transfer to a user’s finger tips. Further, the container disclosed in Ota has a bottleneck top, and is not adapted for nesting. In contrast, the container disclosed in the present application is a nestable container, which creates challenges in design that a non-nestable container like that of Ota do not address. Thus, one skilled in the art would not look to the structures of the high-temperature, non-nestable

container of Ota when designing a container of the present invention. For these additional reasons, the Examiner has not presented a *prima facie* case of obviousness with respect to claim 23.

**New Claims**

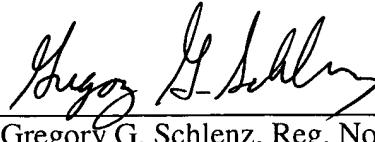
Applicants respectfully submit that new claims 44-46 are patentable over the cited prior art as well. Claims 44-46 contain the limitations, “a longitudinal recess extending upward from the annular shoulder past the mid-height of the sidewall,” and, “the lower portion having a beveled portion extending upward from the base to the arched portion of the shoulder, wherein the beveled portion is immediately adjacent and below the arched portion.” None of the cited prior art discloses, teaches, or suggests these elements of claims 44-46, and there is no motivation in the prior art to modify the cited references to create a container as recited in claims 44-46. Accordingly, Applicants submit that claims 44-46 are in condition for allowance and respectfully request notice of the same.

**CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration of the Examiner's rejections and allowance of Claims 1, 4-31, and 43 in the present Application. Applicants also request examination and allowance of new claims 44-46. Applicants submit that the Application is in condition for allowance and respectfully request an early notice of the same.

Respectfully submitted,

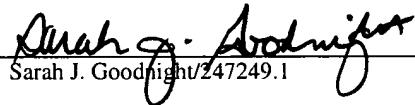
Dated: July 10, 2006

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**CERTIFICATE UNDER (37 C.F.R. § 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 10, 2006.

  
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